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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/979,567	11/26/97	SHIOTA	K 2091-0145P-S
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BIRCH STEWART KOLASCH & BIRCH
P O BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER

HEWITT II, C

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

11/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/979,567	Applicant(s) SHIOTA ET AL.	
	Examiner Calvin L Hewitt II	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-15, 17-21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____. |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 20) <input type="checkbox"/> Other: _____ |

Art Unit: 2161

1. Claims 1-3, 5-9, 10-15, 17-21 and 23-27 have been examined.

Response to Amendment

2. Applicant argues that sufficient motivation was not provided in the Examiner's Office Action, dated May 10, 2000, in order to reject the Applicant's Claims 1-27, filed March 11, 1999.

It is the applicant's contention that:

"... the Examiner has failed to establish motivation for why one of ordinary skill in the art would combine Cloutier et al. with Moghadam/Cameron/PC Magazine Online combination."

To support this claim, the applicant states:

" There must be some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine elements so as to create the same invention. Arkie Lures, Inc. v. Gene Larew Tackle, Inc. 43 USPQ 2d 1294, (Fed. Cir. 1997)"

However, applicant is imposing undue limitation on the appliance and meaning of "obviousness". 35 U.S.C. 103(a) is clear with regard to the usage of "obviousness", for it states that:

Art Unit: 2161

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

In addition, the Examiner cites the following case law that support the Examiner's appropriate application of 35 U.S.C. 103 (emphasis added):

In re Fine, 5 USPQ2d 1596 (CA FC 1988)

"The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that **knowledge generally available to one of ordinary skill in the art** would lead that individual to combine the relevant teachings of the references."

In re Bozek, 163 USPQ 545 (CCPA 1969)

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from **common knowledge and common sense** of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

Art Unit: 2161

In re Gershon, Goldberg, and Neiditch, 152 USPQ 602 (CCPA 1967)

“Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they **do not teach or suggest exactly why this should be done**, other than to obtain the expected superior beneficial results.”

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 6, 11-13, 19 and 25-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the aforementioned claims the applicant uses the language,

“... wherein the printing service information includes information
showing an apparatus and/or...” (emphasis added)

However, in the specification the applicant discloses, “ The **name** of the apparatus or the service provider which has [been] recorded on the printing service information.” (column 5, lines 8-10), “... printing service information showing the printing services that the service provider can provide...” (column 8, lines 3-4), “The name of the service provider or the name or the name of the laboratory system...” (column 12, lines 1-3) and “ identification information comprising the service provider’s name...” when referring to printing service information. The applicant fails to disclose the showing of an apparatus on the printing service information hence the applicant also fails to disclose printing service information that contains **both** an apparatus and a service provider’s name.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, 10, 13-15, 17-21 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219 in view of Cameron et al, U.S. Patent No. 5,592,378, Cloutier et al, U.S. Patent No. 5,229,810 and PC Magazine Online ("Photo Finishing on the Web").

As per Claim 1, Moghadam discloses a picture print ordering system comprising the steps of recording picture image data obtained by reading a developed film (see Figure 4 at ref no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film) and printing service information regarding the printing service which can be provided for the image data in a predetermined recording medium and displaying the printing service information and the image data recorded in the recording medium when the print ordering information is generated (see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes); and generating the print ordering information by using the displayed printing service information (see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col.

2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders for photographs. Moghadam does not disclose that the picture image data is recorded in "high resolution". PC Magazine Online teaches recording high resolution picture image data allowing Web users to "send, download, and print high resolution photographs [page 1, second paragraph]". It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by PC Magazine Online into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

However, neither reference discloses the showing of an apparatus and/or a service provider by which the printing service information has been recorded on a recording medium. Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service has been recorded in the recording medium (see Figure 7). The motivation would be to provide customers with who would be providing the [photograph] services in order to alleviate any fears such as mishandling or unauthorized use of their photos.

As per Claim 2, Moghadam discloses that the printing service information includes the sizes in which a print can be generated (see Figure 5 which displays the available sizes; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes). However, Moghadam does not expressly disclose that the printing service information includes the service charges therefor. Cameron teaches that service information may include the service charges therefor (see Figure 22 and 23, which illustrate service charges for a shirt). Further, PC Magazine Online teaches that customers may order picture prints from picture image data displayed to a customer (page 2, paragraphs 2-4). It would have been obvious to one skilled in the art at the time the invention was made to combine the use of service charges by Cameron and the picture print ordering capabilities of PC Magazine, in order to include picture service charges in the picture print information of Moghadam. The motivation would have been to allow

customers to easily place orders knowing the different sizes that are available and the service charges.

Claims 7, 14, and 20 recite the same limitations as Claim 2, and are rejected for the same reasons.

As per Claim 3, Moghadam does not expressly disclose that the printing service information includes information regarding the available time period of the printing services. However, Cameron teaches that a computerized order entry system can provide service information regarding the availability of services being offered (col. 17, line 60 to col. 18, line 8; explaining that the customer is told if the item is not in stock). It would have been obvious to one skilled in the art at the time the invention was made to incorporate the use of the information regarding the available time period of the printing services by Cameron into the printing service information of Moghadam. The motivation would have been to allow customers to place that could be filled.

Claims 8, 15 and 21 recite the same limitations as Claim 3, and are rejected for the same reasons.

As per Claim 5, Moghadam does not disclose that the printing service information includes information showing the kinds of finishing processing which can be carried out on the picture image when the picture image is printed. However, PC Magazine teaches that the printing service information can include information showing the kinds of finishing processing which can be carried out on the picture image when the picture image is printed (page 2, paragraphs 2-4; explaining that the "PhotoNet" service includes

information on reprints, enlargements, touch-up photos, etc. In addition, the article mentions software developed by Microsoft to edit photos could be sent "over the Web to Kodak after choosing from a palette of sizes, resolutions, and other format options.") It would have been obvious to one skilled in the art at the time the invention was made to combine the finishing information taught by PC Magazine with the printing service information of Moghadam. The motivation would have been to allow customers to make informed purchasing choices by knowing which finishing options existed.

Claims 10, 17, and 23 recite the same limitations as Claim 5, and are rejected for the same reasons.

As per Claim 6, Moghadam discloses a picture print ordering system comprising printing service information recording means which records picture image data obtained by reading a developed film (see Figure 4 at ref no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film) and printing service information regarding the printing services which can be provided to the image data in a predetermined recording medium (see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes); and display means which displays the printing service information recorded in the recording medium and the image data when the print ordering information for requesting a printing service regarding the image data recorded in the medium is generated (see Figure 5, which shows printing service information that was recorded for a customer

order being displayed); and print ordering information generating means which generates the print ordering information by using the displayed printing service information received by the input receiving means (see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam discloses input receiving means which receives input of instruction information using the displayed printing service information (see Figure 4, which shows input means, at 72 via telephone, at 62 via satellite; see Figure 5, which shows a terminal for entering instruction information regarding selection of the individual photographic images along with their respective sizes), he does not expressly disclose a "variety" of the instruction information. Cameron discloses a computerized order entry system for the placement of an ordering instructions for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders with a variety of instruction information for photographs. Moghadam does not disclose that the picture image data is recorded in "high resolution". PC Magazine Online teaches recording high resolution picture image data allowing Web users to cc send, download, and print high resolution photographs [page 1, second

paragraph]". It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by PC Magazine Online into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

However, neither reference discloses the showing of an apparatus and/or a service provider by which the printing service information has been recorded on a recording medium. Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service has been recorded in the recording medium (see Figure 7). The motivation would be to provide customers with who would be providing the [photograph] services in order to alleviate any fears such as mishandling or unauthorized use of their photos.

As per Claim 13, Moghadam discloses a picture print ordering method comprising the steps of recording picture image data, obtained by reading a developed film, and printing service information regarding printing services, which can be provided for the picture image data, on a recording medium by a photo finishing system; displaying the printing service information and the picture image data from the recording medium at a user device, generating print ordering information identifying print services desired for the picture image data at the user device, using the displayed printing service

information; displaying the printing service information and the picture image data from the recording medium at a user device; and, generating print ordering information identifying print services desired for the picture image data at the user device, using the displayed printing service information (see Figure 4 at ref no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes; see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders for photographs. Moghadam does not disclose that the picture

image data is recorded in "high resolution". PC Magazine Online teaches recording high resolution picture image data allowing Web users to C4 send, download, and print high resolution photographs [page 1, second paragraph]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by PC Magazine Online into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

However, neither reference discloses the showing of an apparatus and/or a service provider by which the printing service information has been recorded on a recording medium. Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service has been recorded in the recording medium (see Figure 7). The motivation would be to provide customers with who would be providing the [photograph] services in order to alleviate any fears such as mishandling or unauthorized use of their photos.

As per Claim 18, Moghadam discloses the steps of recording the print order information on the recording medium at the user device, and supplying the recording medium to the photo finishing system to produce prints in accordance with the print order information (Figure 5 shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the

individual images along with their respective sizes; Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices. In order to fulfill the order, the recording medium would be sent to the photo finishing system. Fig. 4 illustrates the communication between the photo finishing center 50 and user 66 having access to personal computer 68 hooked up to telephone line 72. The "recording medium" would consist of the data packets being sent and received among the parties to effect the selection and order of photographs).

Claim 24 recites the same limitations as Claim 18, and is rejected for the same reasons.

As per Claim 19, Moghadam discloses a picture print ordering system comprising: a first recording unit for recording picture image data, obtained by reading a developed film, and printing service information regarding printing services which can be provided for the picture image data on a recording medium by a photo finishing system; a display unit for displaying the printing service information and the picture image data from the recording medium at a user device; and generating unit for generating print ordering information identifying print services desired for the picture image data at the user device, using the displayed printing service information (see Figure 4 at ref no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes; see Figure 5; col. 6, lines 5-8

explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders for photographs.

Moghadam does not disclose that the picture image data is recorded in "high resolution". PC Magazine Online teaches recording high resolution picture image data allowing Web users to "send, download, and print high resolution photographs [page 1, second paragraph]". It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by PC Magazine Online into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure

that the photographs selected for order would appear similar to the actual photographs the customer would receive.

However, neither reference discloses the showing of an apparatus and/or a service provider by which the printing service information has been recorded on a recording medium. Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service has been recorded in the recording medium (see Figure 7). The motivation would be to provide customers with who would be providing the [photograph] services in order to alleviate any fears such as mishandling or unauthorized use of their photos.

As per Claim 25, Moghadam discloses a photo finishing system comprising: an image data obtaining unit which obtains picture image data from a user; a print ordering information obtaining unit which obtains print ordering information regarding the picture image data from the user; and a print generating unit which carries out a variety of printing processes based on the print ordering information, wherein the print ordering information is generated using printing service information and the picture image data displayed on a user device. (see Figure 4 at ref no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes; see Figure 5; col. 6, lines 5-8 explains that an order is

generated by the customer entering next to the respective image the selection choices).

Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders for photographs. Moghadam does not disclose that the picture image data is recorded in "high resolution". PC Magazine Online teaches recording high resolution picture image data allowing Web users to 14 send, download, and print high resolution photographs [page 1, second paragraph]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by PC Magazine Online into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

However, neither reference discloses the showing of an apparatus and/or a service provider by which the printing service information has been recorded on a recording medium. Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service has been recorded in the recording medium (see Figure 7). The motivation would be to provide customers with who would be providing the [photograph] services in order to alleviate any fears such as mishandling or unauthorized use of their photos.

As per Claim 26, Moghadam discloses a computer program embodied on a computer readable medium for ordering prints comprising: a recording source code segment for recording full image picture data, obtained by reading a developed film, and printing service information regarding printing services which can be provided for the picture image data on a recording medium by a photo finishing system; a displaying source code segment for displaying the printing service information and the picture image data from the recording medium at a user device; and a generating source code segment for generating print ordering information identifying print services desired for the high resolution picture image data at the user device, using the displayed printing service information. (see Figure 4 at ref no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their

respective sizes; see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders for photographs. Moghadam does not disclose that the picture image data is recorded in "high resolution". PC Magazine Online teaches recording high resolution picture image data allowing Web users to cc send, download, and print high resolution photographs [page 1, second paragraph]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by PC Magazine Online into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality

photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

However, neither reference discloses the showing of an apparatus and/or a service provider by which the printing service information has been recorded on a recording medium. Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service has been recorded in the recording medium (see Figure 7). The motivation would be to provide customers with who would be providing the [photograph] services in order to alleviate any fears such as mishandling or unauthorized use of their photos.

As per Claim 27, Moghadam discloses a medium comprising: a first recording area for recording picture image data; and a second recording area for recording information regarding printing services, wherein the picture image data and the information regarding printing services are provided together to a customer; the customer ordering a print out according to the information regarding printing services and the picture image data (see Figure 4 at ref no. 42) which shows a photo imaging workstation (PIW) used to create digital images from developed film; see Figure 5, which shows printing service information that was recorded for a customer order and then displayed; col. 6, lines 5-8 explains that the user may select the individual images along with their respective sizes; see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer entering next to the respective image the selection choices). Although

Moghadam does not expressly disclose recording and displaying printing service information for all of the printing services that could be performed on the pictures, order entry systems capable of recording information about a product and then displaying the information to a user are well known. For example, Cameron discloses a computerized order entry system for the placement of an order for an item by a user (col. 2, lines 43-45). The system provides for recording information regarding an item being offered for sale (col. 2, lines 46-48; "A storage mechanism provides for the storing of offer information...") and a data entry system with at least one display (col. 2, 45-46) used to display offer information and to take orders. It would have been obvious to incorporate the complete order entry capabilities of Cameron into the picture print order system of Moghadam. The motivation would have been to allow customers to be able to conveniently place orders for photographs. Moghadam does not disclose that the picture image data is recorded in "high resolution". PC Magazine Online teaches recording high resolution picture image data allowing Web users to "send, download, and print high resolution photographs [page 1, second paragraph]". It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by PC Magazine Online into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

However, neither reference discloses the showing of an apparatus and/or a service provider by which the printing service information has been recorded on a recording medium. Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service has been recorded in the recording medium (see Figure 7). The motivation would be to provide customers with who would be providing the [photograph] services in order to alleviate any fears such as mishandling or unauthorized use of their photos.

4. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219 in view of PC Magazine Online ("Photo Finishing on the Web") and Cloutier et al, U.S. Patent No. 5,229,810.

As per Claim 11, Moghadam discloses a photo finishing system comprising image data obtaining means which obtains picture image data (see Figure 4 at ref no. 42, which shows a photo imaging workstation (PIW) used to create digital images from developed film); print ordering information obtaining means which obtains print ordering information regarding the image data (see Figure 5; col. 6, lines 5-8 explains that an order is accomplished by the customer entering next to the respective image the selection choices; see Figure 4, which shows that ordering information may be obtained by the system via either telephone or satellite communication); and print generating means which carries out a variety of printing processing based on the print ordering information (see Figure 5; col. 6, lines 5-8 explains that an order is generated by the customer

entering next to the respective image the selection choices; the customer chooses which images to print and the sizes); wherein the print ordering information obtaining means obtains print ordering information having been generated by using printing service information and the image data displayed on a predetermined order screen as print services which can be provided for the image data (see Figure 5). Although Moghadam discloses that the print generating means carries out printing processing for providing the printing service displayed as the printing service information, based on the print ordering information (see Figure 5), he does not expressly disclose a "variety of printing processing." PC Magazine teaches that the print generation means may carry out a variety of printing processing (see page 2, paragraphs 2-4; explaining that the "PhotoNet" service includes generating reprints, enlargements, touch-up photos, etc. In addition, the article mentions software developed by Microsoft to edit photos could be sent "over the Web to Kodak after choosing from a palette of sizes, resolutions, and other format options.") It would have been obvious to one skilled in the art at the time the invention was made to combine the print processing taught by PC Magazine with the print processing means of Moghadam. The motivation would have been -to provide photographs that could then be printed in a manner in which the customer found personally attractive.

Moghadam does not disclose that the picture image data is recorded in "high resolution". PC Magazine Online teaches recording high resolution picture image data allowing Web users to cc send, download, and print high resolution photographs [page 1, second paragraph]. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to incorporate the use of high resolution as taught by PC Magazine Online into the picture print order system of Moghadam. The motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

However, neither reference discloses the showing of an apparatus and/or a service provider by which the printing service information has been recorded on a recording medium. Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service has been recorded in the recording medium (see Figure 7). The motivation would be to provide customers with who would be providing the [photograph] services in order to alleviate any fears such as mishandling or unauthorized use of their photos.

5. Claim 12 is rejected under 35 U. S. C. 103 (a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219, in view of PC Magazine Online ("Photo Finishing on the Web"), and Cloutier et al, U.S. Patent No. 5,229,810.

As per Claim 12, Moghadarn discloses a program comprising the steps of displaying printing service information and image data of a picture image recorded in a predetermined recording medium on a display apparatus connected to a computer (see Figure 4 at ref no. 42, which shows a photo imaging workstation (PIW) used to create

digital images from developed film; see Figure 5, which shows picture images and print service information displayed on a terminal); enabling instruction information using the displayed printing service information to be input by input devices of the computer (col. 6, lines 5-8 explains that an order is accomplished by the customer inputting next to the respective image the selection choices; col. 5 lines 66-7 to col. 6 line I notes that the screen shown in Figure 5 could be either a home computer or the screen of a TV); and generating the print ordering information based on the instruction information input by the input devices (col. 6, lines 5-8). Although Moghadam discloses more than one type of input device, i.e., home computer and TV, he does not expressly disclose a "variety of input devices." Cloutier teaches that printing service information may be recorded on an magnetic strip which can be read by an input device connected to a computer (col. 3 lines 39-55 summarizing his invention; Figure 2 shows that the read/write process is attached to a microprocessor). It would have been obvious to combine Cloutier's input device, along with other well known input devices, e.g., mouse, light pen, with Moghadam's input devices. The motivation would have been to provide a print ordering system that is more user friendly. Moghadarn does not disclose that the picture image data is recorded in "high resolution". PC Magazine Online teaches recording high resolution picture image data allowing Web users to "send, download, and print high resolution photographs [page 1, second paragraph]": It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of high resolution as taught by PC Magazine Online into the picture print order system of Moghadam. The

motivation would have been to provide customers with higher quality photographic images in order to ensure that the photographs selected for order would appear similar to the actual photographs the customer would receive.

However, neither reference discloses the showing of an apparatus and/or a service provider by which the printing service information has been recorded on a recording medium. Cloutier teaches that printing service information may be recorded on a magnetic strip which includes information showing an apparatus and/or a service provider by which the printing service has been recorded in the recording medium (see Figure 7). The motivation would be to provide customers with who would be providing the [photograph] services in order to alleviate any fears such as mishandling or unauthorized use of their photos.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 305-0625. The examiner can normally be reached on Monday-Friday from 8:30 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to"

Commissioner of Patents and Trademarks

C/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051 (for formal communications intended for entry)

or:

(703) 308-5397 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,

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Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Calvin Loyd Hewitt II

October 20, 2000



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100